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09/613,123	07/10/2000	William N. Schilit	FXPL-01022US0	8793
23910 7590 05/27/2009 FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108				
EXAMINER				
HALIM, SAHERA				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/613,123

**Applicant(s)**

SCHILIT ET AL.

**Examiner**

SAHERA HALIM

**Art Unit**

2457

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/88)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 3/9/09

### **DETAILED ACTION**

1. This Office Action is responsive to RCE filled on March 9, 2009.
2. Claims 1-8 and 10-15 are pending.
3. Claims 1, 10 and 11 have been amended.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4, 6, 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed invention as a whole does not produce a tangible result.

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a 35 U.S.C. 101 judicial exception, in that the process claim must set forth a practical application of that judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application.”). “[A]n application of a law of nature or mathematical formula to a ... process may well be deserving of patent protection.” Diehr, 450

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U.S. at 187, 209 USPQ at 8 (emphasis added); see also Corning, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 (“It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . .”). In other words, the opposite meaning of “tangible” is “abstract.”

In this case, **claims 4, 6 and 8** produces result only when the if condition is met. When the if condition in these claims are not met, there is no result. and claims 6 and 8 even lacks antecedence basis. Thus, claim 4, 6 and 8 are directed in part to an “abstract idea” The claims lack “**tangible results**“. There are no tangible results being produced when the if condition is not met.

4. Claims 10 and 11 are rejected under the same rational as they recite similar limitations. Any claims depending on claims 4, 6, 8, 10 and 11 are necessarily rejected as being dependent upon the rejection of the above claims.

Claims 1-8, and 10-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**MPEP 2106 IV.B.2.(b)**

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

Claims 1-8, and 10-15, in view of the above cited MPEP sections, are not statutory because they merely recite a number of computing steps

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without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 10, and 11 recites the limitation "wherein each of the one or more web content data items comprises text in the Web page **that is** contact information for one of a person and an entity" in the claims. There is insufficient antecedent basis for this limitation in the claim. For examination purposes this limitation is read as "wherein each of the one or more web content data items comprises text in the Web page, wherein the text is contact information for one of a person and an entity".

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claims 1-4, and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat No. 6,870,828 to Giordano, III (hereinafter Giordano).

9. Regarding claim 1, Giordano discloses a method for proving data detection from Web content information for a mobile device comprising the steps of (see abstract):

receiving a URL from a user (see col. 1, line 15 - 19; user has access to Web page);

accessing a Web page identified by the URL (see col. 2, line 64 – col. 3, line 15; the web techniques described in pat. 5, 250,940);

parsing the currently accessed Web page dynamically in real time to identify one or more non-hyperlink Web content data items in the Web page (col. 3, line, line 16 – 43; the webpage is parsed for telephone numbers in the text) wherein each of the one or more web content data items comprises text in the web page that is contact information for one of a person and an entity (see col. 4, line 47 - 67; the software is configured to recognize identification).

creating one or more link indications that correspond to the one or more non-hyperlink content data items (see col. 3, line 33 – 49; the identified numbers are iconified) and

displaying to the mobile device the one or more link indications for selection by a user (col. 3, line 22 – 43; the information is displayed on a cellular phone's screen), each link indication providing a link to a service through a wireless connection from the mobile device (see col. 4, line 47 – 67; Technical

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Support, and Sales provide different services), and each service performing a service related to a type of contact information of the Web content data item, for the Web content data item corresponding to a link indication (see col. 4, line 47 – 67; Technical Support, and Sales that provide different services for the text associated on the webpage).

10. Regarding claim 2, Giordano discloses the method of claim 1 further comprising the steps: providing a user keypad on the mobile device to enable the user to select one of the one or more link indications to be activated (col. 3, line 16 - 49); and activating one of the one or more link indications when the user selects the particular one of the one or more link indication (col. 3, line 22 – 49).

11. Regarding claim 3, Giordano discloses wherein one of the one or more Web content data items comprises a telephone number (see col. 4, line 6 – 27).

12. Reference to claim 4, Giordano discloses the method of claim 2, wherein if one of the one or more web content data item is a telephone number and the corresponding at least one link indication is activated, and the telephone number is dialed by the mobile device (see col. 3, line 22 - 63).

13. Regarding claim 12, Giordano discloses wherein the mobile device can be one of:

an Internet phone (col. 3, line 25 -32);

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a personal digital assistant (col. 3, line 25 -32); and

a two way pager (col. 3, line 25 -32).

14. Reference to claims 13 and 14, Giordano discloses wherein parsing the currently accessed Web page occurs in a network server and within a Web browser (col. 3, line 4 - 15).

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 5-8, and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano in view of <http://www.hpl.hp.com/techreports/2000/HPL-2000-16-pdf>) by Kindberg et al. (hereinafter Kindberg).

17. Regarding claim 5, Giordano fails explicitly disclose wherein one of the one or more web content data items comprises a street address. However, Kindberg discloses the web content data items comprises a street address (see page 5, 2.4) Having the teachings of Giordano and Kindberg, it would have been obvious to a person having ordinary skill in the art at the time the invention was



made to modify Giordano by providing a link to a street address in order to enhance the system functionality disclosed by Giordano.

18. Regarding claim 6, Giordano does not disclose the method of claim 2, wherein if one of the one or more Web content data items is a street address and the corresponding at least one link indication is activated, displaying to the mobile device the location of the street on an online map. However, Kindberg discloses wherein if one of the one or more Web content data items is a street address and the corresponding at least one link indication is activated, displaying to the mobile device the location of the street on an online map (see page 5, 2.4). Having the teachings of Giordano and Kindberg, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Giordano by providing a link to a street address and displaying the location of the street on a map as disclosed by Kindberg in order to enhance the system functionality disclosed by Giordano.

19. Regarding claim 7, Giordano fails to disclose wherein one of the one or more Web content data item is an e-mail address. However, Kindberg discloses the Web content data is an e-mail address (pg.3, section 2.1). Having the teachings of Giordano and Kindberg, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Giordano by providing a link to an e-mail address as disclosed by Kindberg in order to enhance the system functionality disclosed by Giordano.

20. Regarding claim 8, Giordano fails to disclose the method of claim 2, wherein if the one of the one or more Web content data items is an email address and the corresponding at least one link indication is activated, initiating an email to the email address by the mobile device (pg.3, section 2.1). Having the teachings of Giordano and Kindberg, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Giordano by providing a link to an e-mail address and initiating an email by the mobile device when the link is activated as disclosed by Kindberg in order to enhance the system functionality disclosed by Giordano.

21. Regarding claim 10, Giordano teaches a method for providing a location on an online map of a street address associated with Webpage information comprising the steps of:

receiving a URL from a user (col. 1, line 15-19; user has access to webpage);

accessing a Web page identified by the URL (col. 2, line 64 – col. 3, line 15; the web techniques described in pat. 5,250,940);

parsing the currently accessed Web page dynamically in real time to identify one or more Web content data items in the Web page (col. 3, line 16 - 43; the webpage is parsed for phone numbers in the text), wherein each of the one or more Web content data items comprises text in the Web page that is

contact information for one of a person and entity (see col. 4, line 47-67; the software is configured to recognize identification);

providing a user keypad on the mobile device to enable the user to select the link indication (col. 3, line 22 – 49); and

Giordano fails to teach if one of the one or more Web content data items comprises a street address, then displaying to the mobile device a link indication that corresponds to the street address, the link indication providing a link to an online map service through a wireless connection from the mobile device

displaying to the mobile device by the online map service the location of the street address on an online map if the user selects the link indication to activate the link.

However, Kindberg teaches if one of the one or more Web content data items comprises a street address, then displaying to the mobile device a link indication that corresponds to the street address, the link indication providing a link to an online map service through a wireless connection from the mobile device (see page 5, 2.4)

displaying to the mobile device by the online map service the location of the street address on an online map if the user selects the link indication to activate the link (see page 5, 2.4). Having the teachings of Giordano and Kindberg, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Giordano by providing a link to a street address and displaying the location of the street on a map as disclosed by Kindberg in order to enhance the system functionality disclosed by Giordano.

22. Regarding claim 11, Giordano teaches a method for initiating an email for an email address associated with Web page information comprising the steps of:

receiving a URL from a user (col. 1, line 15-19; user has access to webpage);

accessing a Web page identified by the URL (col. 2, line 64 – col. 3, line 15; the web techniques described in pat. 5,250,940);

parsing the currently accessed Web page dynamically in real time to identify one or more Web content data items in the Web page (col. 3, line 16 - 43; the webpage is parsed for phone numbers in the text), wherein each of the one or more Web content data items comprises text in the Web page that is contact information for one of a person and entity (see col. 4, line 47-67; the software is configured to recognize identification);

providing a user keypad on the mobile device to enable the user to select the link indication (col. 3, line 22 – 49); and

Giordano fails to teach if one of the one or more Web content data items comprises an email address, then displaying to the mobile device a link indication that corresponds to the email address, the link indication providing a link to an email service through a wireless connection from the mobile device; and initiating an email to the email address by the mobile device using the email service if the user selects the link indication to activate the link.

However, Kindberg teaches if one of the one or more Web content data items comprises an email address, then displaying to the mobile device a link

indication that corresponds to the email address, the link indication providing a link to an email service through a wireless connection from the mobile device; and initiating an email to the email address by the mobile device using the email service if the user selects the link indication to activate the link (pg.3, section 2.1). Having the teachings of Giordano and Kindberg, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Giordano by providing a link to an e-mail address and initiating an email by the mobile device when the link is activated as disclosed by Kindberg in order to enhance the system functionality disclosed by Giordano.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giordano. Giordano teaches wherein displaying to the mobile device the one or more link indication for selection by a user comprises:

receiving the user's selection of one of the one or more link indication (col. line 22 – 67); link indication providing a link to a service through a wireless connection from the mobile device, and each service performing a service related to a type of contact information of the Web content data item, for the Web content data item corresponding to the received selected one of the one or more link indications (see col. 4, line 47 – 67; Technical Support, Sales that provide different services).

Giordano fails to teach displaying to the mobile device a plurality of additional link indication for selection by the user after receipt of the user's selection of one of the one or more link indications. However, having the

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teachings of Giordano, it would have been obvious for a person having ordinary skill in the art at the time of the invention to modify Giordano by displaying to the mobile device a plurality of additional link indication for selection by the user after the receipt of the user's selection of one of the one more link indications because it would allow the system to capture additional contact information on additional WebPages.

**It is noted that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonable suggested to one having ordinary skill in the art. In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968))**

### ***Response to Arguments***

23. Applicant's arguments with respect to claims 1-8 and 10-15 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US. Pat. Pub. No. 2002/0055351 to Elsey et al. (providing personalized data and communications services)

US. Pat. Pub. 2009/0037282 to McCrossin et al (providing local information on a network)

US. Pat. No. 5,862,321 to Lamming et al. (menus for services).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAHERA HALIM whose telephone number is (571)272-4003. The examiner can normally be reached on M-F from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)? If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sahera Halim  
Patent Examiner

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